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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,902	01/28/2002	Shinichi Koyama	03500.016144	2051
5514 7590 01/09/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER VIEAUX, GARY	
			ART UNIT 2622	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/055,902

Applicant(s)

KOYAMA, SHINICHI

Examiner

Gary C. Vieaux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 13-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this
5 application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 14, 2006, has been entered.

10

Amendment

In response to the most recent Office Action, dated July 14, 2006, claims 1, 2, 5, and 6 have been amended.

Response to Arguments

15

Applicant's arguments have been fully considered but they are not persuasive. Regarding amended independent claims 1 and 5, Applicant respectfully submits "that none of Miyaji, Saito, et al., and Official Notice, even in the proposed combinations, assuming, *arguendo*, that the same could be combined, discloses or suggests at least the above-discussed claimed combinations of claimed features as recited, *inter alia*, in
20 Claims 1 and 5" (Emphasis added by Applicant; Remarks of November 14, 2006, p.7.) The Examiner respectfully disagrees.

In addition to the control structure for the internal and external recording units taught by Miyaji, Saito is found to teach both the capability of determining if and what external storage device is connected (col. 5 line 66 – col. 6 line 29), and the use of an IEEE 1394 interface (col. 12 lines 48-50; which allows for automatic recognition of a connected device by way of “plug-n-play” functionality.) It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the automatic recognition as taught by Saito with the control structure as taught by Miyaji as a means to allow for the conservation of power via reduced processing when the external device is not found to be connected, as well as a means to allow for reduced user interaction via the plug-n-play functionality. Taken in concert with the other teachings of Miyaji and Examiner’s Official Notice regarding the inclusion of audio along with video within an image capture device, all of the combined limitations of claims 1 and 5 are found to be disclosed. Therefore, the Examiner respectfully stands behind the 35 U.S.C. 103(a) rejection to claims 1 and 5.

Additionally, Applicant appears to attempt to traversal of the Examiner’s Official Notice, “Further, the taking of Official Notice is respectfully traversed in the absence of a cited document” (p. 7, Amendment dated November 14, 2006.) However, “to adequately traverse such a finding, an applicant must specifically point out the supposed errors in the Examiner’s action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art “. See MPEP §2144.03 and 37 CFR 1.111(b). Applicant’s traversal amounts to a mere allegation of patentability over the common knowledge/well-known in the art, to which, the MPEP

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states, "A general allegation that the claims define a patentable invention ... would be inadequate." Again see MPEP §2144.03. Because the Applicant has not specifically pointed out the supposed errors in the Examiner's action, including stating why the noticed fact is not considered to be common knowledge or well-known in the art, the

5 Examiner finds the traversal to be inadequate.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

10 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15

Claims 1-8 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyaji (US 5,206,739) in view of Saito et al. (US 6,184, 922), in further view of Examiner's Official Notice.

Regarding claim 1, Miyaji discloses an image capture apparatus comprising an
20 image capture unit adapted to capture an image and output image data (col. 3 lines 8-15), an internal recording unit (fig. 1 indicator 1) adapted to (a) start recording the image on a recording medium in response to a record start instruction, and (b) stop recording the image on the recording medium in response to a record stop instruction (col. 3 lines 45-62), and a communication unit being capable of connecting with an external storage
25 device and outputting the image (fig. 1), wherein said communication unit starts outputting the image in response to the instruction of starting recording (col. 5 line 62 –

col. 6 line 8), and wherein said communication unit stops outputting the image in response to an instruction of stopping recording (col. 5 line 62 – col. 6 line 8.) Miyaji also discloses a control unit (fig. 1 indicator 6) adapted to determining whether the internal recording unit becomes unable to record the image data when the

5 communication unit is outputting the image data, as well as discloses wherein if it is determined that said internal recording unit becomes unable to record the image data on the recording medium when said communication unit is outputting the image data, said control unit disables output of the image data from said communication unit in response to the record stop instruction (col. 5 line 10 – col. 6 line 26.)

10 However, although Miyaji discloses operation of the external storage unit based on circuitry state, which inherently implies connectivity for any high signal states to exist, it does not disclose the image capture apparatus making an explicit determination that the external storage device is connected, nor does Miyaji disclose enabling output of data in response to a record start instruction if it is determined that the external storage
15 device is connected. Additionally, Miyaji does not explicitly disclose a microphone unit or associated sound data.

 Nevertheless, Saito discloses an image capture apparatus with the capability of determining if and what external storage device is connected (col. 5 line 66 – col. 6 line 29), as well as discloses the use of an IEEE 1394 interface (col. 12 lines 48-50.) It
20 would have been obvious to one of ordinary skill in the art at the time the invention was made to provide for the determination of connectivity of an external storage device in order to allow for indication of the type of external storage device (in the case of Saito,

either still image or motion picture capabilities; and particularly the "plug-n-play" functionality of the IEEE-1394 interface connectivity, which allows for automatic recognition of a connected device and reconfiguration according to this "awareness") or as means to indicate to a user that an external device is actually functionally connected.

5 It would have been further obvious to one of ordinary skill in the art at the time the invention to incorporate determination of connectivity as taught by Saito, with the control functionality of the internal/external recording unit as taught by Miyaji, in order to conserve power via reduced processing when the external device is not found to be connected, as well as to take advantage of the reduced user interaction provided by the
10 plug-n-play functionality.

Additionally, although neither Miyaji nor Saito explicitly disclose a microphone unit or associated sound data, Official Notice is taken that an image capture apparatus may record sound data via a microphone unit in concert with the recording of image data; a concept that is well known and expected in the art. It would have been obvious
15 to one of ordinary skill in the art at the time the invention was made to record sound data via a microphone unit in order to record the audio associated with the images being recorded, and therefore capture a more representative rendition of the recorded event.

Regarding claim 2, Miyaji and Saito, in further view of Examiner's Official Notice,
20 disclose all the limitations of claim 2 (see the 103(a) rejection to claim 1 supra) including disclosing an image capture apparatus wherein even if said internal recording unit becomes unable to record the image and sound data on the recording medium said

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control unit does not discontinue output of the image and sound data from the communication unit ('739 – col. 5 line 62 – col. 6 line 26.)

Regarding claim 3, Miyaji and Saito, in further view of Examiner's Official Notice, disclose all the limitations of claim 3 (see the 103(a) rejection to claim 1 supra) including
5 teaching an apparatus wherein said communication unit outputs the image and sound data by using an isochronous transfer conformed to IEE1394-1995 standards ('922 - col. 12 lines 48-50.)

Regarding claim 4, Miyaji and Saito, in further view of Examiner's Official Notice, disclose all the limitations of claim 4 (see the 103(a) rejection to claim 1 supra) including
10 teaching an apparatus wherein the apparatus is a camera-integrated digital video recorder ('922 - col. 4 lines 37-44, in which the camera, indicator 4 of fig. 1, can be integrated with a DVD-R or DVD-RAM drive.)

Regarding claim 13, Miyaji and Saito, in further view of Examiner's Official Notice, disclose all the limitations of claim 13 (see the 103(a) rejection to claim 1 supra)
15 including wherein the image and sound data is conformed to an MPEG2 transport stream ('922 – col. 19 lines 59-63.)

Regarding claims 5-8 and 14, although the wording is different, the material is considered substantively equivalent to claims 1-4 and 13, respectively, as discussed above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Thompson, D. (*IEEE 1394: changing the way we do multimedia ommunications*,
5 Multimedia IEEE, April-June 2000) discloses aspects and highlights of associated with 1394 connectivity.

Santamaria, R. (IEEE-1394: a standard for the next millennium, Digital Avionics Systems Conference, 1999) discloses aspects and highlights of associated with 1394 connectivity.

10

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Vieaux whose telephone number is 571-272-7318. The examiner can normally be reached on Monday - Friday, 8:00am - 4:00pm.

15 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NgocYen T. Vu can be reached on 571-272-7320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.


Status information for unpublished applications is available through Private PAIR only.

- 5 For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Gary C. Vieaux
Examiner
Art Unit 2622

Gcv2


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SUPERVISORY PATENT EXAMINER